



UNITED STATES DEPARTMENT OF COMMERCE
Pat nt and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/445,919	03/16/00	STJERNSCHANTZ	J 10806-106

DINSMORE & SHOHL
255 EAST FIFTH STREET
1900 CHEMED CENTER
CINCINNATI OH 45202

HM22/0306

EXAMINER

FAY, Z

ART UNIT	PAPER NUMBER
1614	8

DATE MAILED: 03/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/445,919

Applicant(s)

Stjerschantz et al.

Examiner

Zohreh Fay

Group Art Unit

1614



☐ Responsive to communication(s) filed on _____

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-11 and 13-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-11 and 13-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

Claims 1-11 and 13-23 are presented for examination.

The amendments and remarks filed on December 12, 2000 have been received and entered.

Claims 1-11 and 13-23 are rejected under 35 U.S.C. 103 as being unpatentable over WO 9408585 and Klunder for the reasons set forth on page 2 of the office action of September 7, 2000.

Applicant's arguments and remarks have been carefully considered, but are not deemed to be persuasive. Claims 1-5 and 13-17 are directed to a pharmaceutical composition, which basically reads on the claimed compounds in combination with a pharmaceutically acceptable carrier. Applicant's attention is directed to *In re Dillon*, 16 USPQ2d 1897 at 1900 (CAFC 1990). The court sitting in banc ruled that the recitation of a new utility for an old and well known composition does not render that composition new. Thus, to use an old composition for a new purpose does not create a patentably distinct composition. The determination of optimum proportions or amounts are within the skill of the artisan. Claims 6-11 and 18-21 are directed to a use of the prostaglandin E and F for the treatment of glaucoma. WO clearly teaches the use of prostaglandin E and F for the treatment of glaucoma. The dependent claims are directed to the use of specific prostaglandin E and F for the treatment of glaucoma. Since prostaglandins E and F in general are used for the treatment of glaucoma, it would have been obvious to a person skilled in the art to use their derivatives for the same purpose in the absence of evidence to the contrary. There is also no evidence of record to demonstrate the reduced melanogenesis using prostaglandins E and F. Applicant has presented no evidence to establish

Art Unit:

the unexpected or unobvious nature of the claimed invention, and as such, claims 1-11 and 13-23 are properly rejected under 35 U.S.C. 103.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner fay whose telephone number is (703) 308-4604.

ZOHREH FAY
PRIMARY EXAMINER
GROUP 1200

